UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,389	04/20/2001	Daniel C. Castle	10006967-1	2509

7590 03/14/2006	EXAMINER
HEWLETT-PACKARD COMPANY	LASTRA, DANIEL

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O.Box 272400
Fort Collins, CO   80527-2400

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/839,389	CASTLE, DANIEL C.
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 December 2005_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-22_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-22 have been examined. Application 09/839,389 (BACKGROUND

ADVERTISING IN AN INTERNET ENVIRONMENT) has a filing date 04/20/2001.

Response to Amendment

2.   In response to Non Final Rejection filed 09/23/2005, the Applicant filed an

Amendment on 12/23/2005, which amended claims 1, 6, 12, 17 and 20.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Regarding claims 1, 6, 12, 17 and 20 the phrase "capable of" renders the

claim(s) indefinite because the claim(s) refer to the potential of the action and leaves in

doubt whether the action is encompassed in claims 1, 6, 12, 17 and 20.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1, 6, 12, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention. Claims 1, 6, 12, 17 and 20 recites the

phrases "automatically" and "dynamically" and nowhere in Applicant's specification

those terms are mentioned or explained. For purpose of art rejection, "automatically"

would be interpreted as a server computer reading a client's computer device

information which contains the type of equipment on which said client computer is

running and "dynamically" would be interpreted as simply making a change to a computer display object.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rashkovskiy (US 6,616,533) in view of Angles (US 5,933,811) and further in view of Harris (US 2003/0023755).

As per claims 1, 6 and 12, Rashkovskiy teaches:

A method for displaying advertisements over the Internet to a computer device comprising the steps of:

displaying on the computer device informational content on a first layer (see figure 8, item 122) *that is capable of being updated by a network* (see Rashkovskiy column 2, lines 46-52; "video game may be played over the Internet, therefore, being capable of being updated by a network);

determining advertising content related to the information content (see Rashkovskiy see abstract "once the game play is paused, an advertising graphical user

interface may be displayed that enables the user to purchase items associated with image elements observed in the course of game play");

displaying on the computer device muted advertisement content behind the informational content, on a second layer, (see Rashkovskiy figure 8, items 112, 116, 118, 120, 114) such that both the informational content (i.e. information of playing the game, such as moving cars) and the advertisement content are viewable simultaneously (see Rashkovskiy figure 8)

wherein contrast of the second layer is less than the first layer (see Rashkovskiy figure 8; the background image and the content image needs to have a different level of contrast to be displayed and viewed simultaneously);

displaying on the computer device non-transparent hyper-linked advertisement content on the first layer that is related to the advertisement content on the second layer (see Rashkovskiy column 5, lines 10-20; figure 8, items 112-120 are clickable background images) but fails to teach wherein the advertising content is updated when changes occur to a profile of an Internet consumer *and wherein the advertising content dynamically changes based on changes from the network to the information content* and also fails to teach but fails to teach *with the advertisement content having a level of transparency that is automatically adjusted according to capabilities of the computer device.* However, Harris teaches the use of "cookies" in the header of the HTPP request from a user's computer device in order to determine the capabilities of said device and transmit content to said device based upon said device capabilities (i.e. screen size or color depth; see Harris paragraph 24). Angles teaches the use of "cookies" to determine

the consumer's profile and the content provider information in order to select an appropriate advertisement from the advertisement database based upon said profile and/or content information (see Angles column 11, lines 5-50; column 15, lines 20-32). Rashkovskiy teaches in column 3, lines 35-50 "In some embodiments of the present invention, a connection to a network such as the Internet may be utilized to update the advertising. Additional advertising may be provided for additional hot clickable elements. Moreover, the advertising subject matter may be modified. Particularly, in connection with advertising associated with background material, the sponsoring advertising may be modified by downloading new software periodically. Thus, in one embodiment of the present invention, a sponsor may sponsor a background image in the course of the game and after a period of time may no longer continue that sponsorship. A new sponsor may assume the position previously occupied by the previous sponsor. At such time, new software may be downloaded to change the background material". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rashkovskiy would be motivated to adjust the level of transparency or color depth of a background advertisement based upon user's computer capabilities, as taught by Harris and would display background advertisements in online games (see Rashkovskiy figure 8, item 114), where said advertisements would be customized and updated based upon user's profile and content provider information, as taught by Angles in order to target advertisements that would have a higher probability to reach and being able to be displayed by their intended target. Rashkovskiy would be motivated to target advertisements displayed in

the background of an online game of a user's device based upon user's profile, device capabilities and content information in order to display advertisements and content to a user more likely to use the product or offer which would also have the computer capabilities to display said offers. Rashkovskiy would also be motivated to incorporate said advertisements in the background of on-line game in order to associate said advertisements with entertainment (i.e. playing a fun game) and therefore, increasing the probability that said advertisements would be viewed and click by a user of said game.

As per claim 2, Rashkovskiy teaches:

The method of claim 1 and further including the step of displaying both the first and the second layers on a monitor device such that both layers are viewable simultaneously (see figure 8; column 5, lines 10-20).

As per claims 3, 4 and 8, Rashkovskiy teaches:

The method of claim 1 but fails to teach and further including the step of printing both the first and the second layers on a page such that both layers are viewable simultaneously and printing the first and second layers. However, Official notice is taken that it is old and well known in the computer art to print an image that is displayed in the active area of a computer screen. It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention was made to know that a image consisting of a content with a background advertisement that is displayed in a computer screen would be printed using a computer printer.

As per claim 5, Rashkovskiy teaches:

The method of claim 1 wherein the advertisement content on the first layer, and the advertisement content on the second layer are related by a common product or service (see figure 8, items 112-120).

As per claim 7, Rashkovskiy teaches:

The method of claim 6 and further including the step of the client process requesting delivery of the first and second layers (see column 2, lines 1-20).

As per claim 9, Rashkovskiy teaches:

The method of claim 7 wherein the client process is resident on a personal computer comprising a monitor device (see column 2, lines 20-35).

As per claim 10, Rashkovskiy teaches:

The method of claim 7 but fails to teach and further including the step of the client process requesting a predetermined level of transparency of the second layer. However, the same argument made in claim 1 regarding the transparency limitation is also made in claim 10. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rashkovskiy would adjust the level of transparency of a background advertisement in order to adjust the contrast between the content image and the background image displayed in the computer screen so both images can be viewed simultaneously.

As per claim 14, Rashkovskiy teaches:

The system of claim 12 wherein the storage media stores information relating to the client process (see column 2, lines 7-50).

As per claim 15, Rashkovskiy teaches:

The system of claim 14 wherein the processor has means for determining an advertisement content from the plurality of advertisement content in response to the information relating to the client process (see column 3, lines 35-50).

As per claim 16, Rashkovskiy teaches:

The system of claim 12 wherein the client process is an automatic content delivery service that requests information content from predetermined Internet resources (see column 3, lines 35-50).

As per claims 11, 13, 17, 19, 20, 21 and 22, Rashkovskiy teaches:

receiving a request for predetermined information content *that is capable of being updated by a network;*

accessing the predetermined information content from memory (see column 4, lines 5-52);

determining advertising content related to the informational content (see Rashkovskiy see abstract "once the game play is paused, an advertising graphical user interface may be displayed that enables the user to purchase items associated with image elements observed in the course of game play"), but fails to teach wherein the advertising content is updated when changes occur to a profile of an Internet consumer. However, the same argument made to claim 1 is made to claim 20;

accessing the advertising content having a predetermined transparency level;

adjusting the predetermined transparency level of the advertising content;

combining the advertisement content with the predetermined information content to form a Web page so the transparent advertising content is muted (see <u>Rashkovskiy</u> figure 8, items 112, 116, 118, 120, 114),

wherein contrast of the advertising content is less than the information content (see <u>Rashkovskiy</u> figure 8; the background image and the content image needs to have a different level of contrast to be displayed and viewed simultaneously) but fails to teach *with the advertisement content having a level of transparency that is automatically adjusted according to capabilities of the computer device and wherein the advertising content dynamically changes based on changes from the network to the information content.* However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 17.

displaying non-transparent hyper-linked advertisement content that is related to the transparent advertisement content (see <u>Rashkovskiy</u> figure 8, column 5, lines 10-20) but fails to teach and further including the step of the transparency of the advertisement content being adjusted to the predetermined level in response to a composition of the computer device and that first layer and the second layer can be viewed simultaneously. However, the same argument made in claim 1 regarding the transparency limitation is also made in claim 17.

As per claim 18, <u>Rashkovskiy</u> teaches:

The method of claim 17 wherein the request for predetermined information content is transmitted by the client process (see Rashkovskiy column 10, lines 1-26).

Response to Arguments

5.   Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.   Accordingly, **THIS ACTION IS MADE FINAL**.   See MPEP § 706.07(a).   Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.   In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.   In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720.   The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724.   The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
March 1, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER